

REMARKS

Claims 1-49 are pending in the present application. Claim 1 stands rejected under 35 U.S.C. §102(b) for anticipation by U.S. Patent No. 5,166,680 to Ganot (the Ganot patent). Claims 1-20, 22-24, 26, 31-32, 34-36 and 38-40 stand rejected under 35 U.S.C. §103(a) for obviousness over U.S. Patent No. 5,649,296 to MacLellan et al. (the MacLellan patent) in view of U.S. Patent No. 5,493,437 to Lebby et al. (the Lebby patent) and the Ganot patent. Claims 21, 25, 33, 37 and 41 stand rejected under 35 U.S.C. §103(a) for obviousness over the MacLellan patent in view of the Lebby patent and the Ganot patent and further in view of U.S. Patent No. 4,461,793 to Block et al. (the Block patent). Claims 27-29 stand rejected under 35 U.S.C. §102(b) for anticipation by U.S. Patent No. 5,462,374 to Kohno (the Kohno patent). Claim 30 stands rejected under 35 U.S.C. §103(a) for obviousness over the Kohno patent in view of the MacLellan patent. Claims 42-49 stand rejected under 35 U.S.C. §103(a) for obviousness over the Kohno patent in view of the Ganot patent.

Applicant traverses the rejections and urges allowance of all pending claims.

Referring to the rejections under 35 U.S.C. §102(b), the PTO and Federal Circuit provide that §102 anticipation requires that *each and every element* of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a

1 cited §102 reference of *any* claimed element negates the anticipation.
2 *Kloster Speedsteel AB, et al. v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81
3 (Fed. Cir. 1986).

4 Further, the teachings of the references do not support an
5 obviousness rejection of the claims. An obviousness rejection requires
6 consideration of all the elements of the claimed invention. Further, all
7 such elements must be shown to be suggested by the prior art when
8 making a rejection based upon obviousness under 35 U.S.C. §103(a).
9 *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1987). The test
10 for obviousness is what the combined teaching of the references would
11 have suggested to those of ordinary skill in the art. *In re Keller*, 642
12 F.2d 413, 208 USPQ 871, 881 (CCPA 1981), MPEP §2145(c).

13 Independent claim 1 defines the remote intelligent communication
14 device comprising, in part, upper and lower surfaces individually having
15 plural dimensions and at least one side having a dimension less than
16 smallest dimensions of the upper and lower surfaces. Such is clearly
17 illustrated in Fig. 4 of the present application.

18 Referring to Fig. 1 of the Ganot patent, it is asserted that
19 component 10 includes a side (front view of 10) having visibly
20 perceptible information thereon as set forth on page three of the Office
21 Action. Applicant has amended claim 1 to define at least one side
22 having a dimension less than smallest dimensions of the upper and lower
23 surfaces. It is clear from Fig. 1 of the Ganot patent that
24 component 10 includes a height of the front surface which is greater

1 than the dimensions of the other surfaces. The Ganot patent fails to
2 teach or suggest the remote intelligent communication device defined in
3 amended claim 1. Claim 1 complies with the requirements of 35
4 U.S.C. §102(b).

5 Referring now to the obviousness rejections, the Ganot patent
6 comprises non-analogous art to Applicant's invention. The Ganot patent
7 relates to a portable parking meter device and method of operating the
8 same. Such is clearly non-analogous to remote intelligent communication
9 devices or radio frequency identification devices (RFID).

10 Non-analogous art areas cannot properly be combined for an
11 obviousness rejection where the problems addressed by each are non-
12 analogous from one another. *In re Deminski*, 230 USPQ 313, 315 (Fed.
13 Cir. 1986.) A field of art is analogous *only* if one seeking the solution
14 in one art area would be likely to seek the solution by referring to the
15 other art. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 225
16 USPQ 634 (Fed. Cir. 1985). Prior art references are only analogous if
17 the reference is in the field of Applicant's endeavor or the reference
18 is reasonably pertinent to the particular problem with which the inventor
19 was concerned. MPEP §2145(i) (citing *In re Oetiker*, 977 F.2d 1443, 24
20 USPQ2d 1443, 1445 (Fed. Cir. 1992)). The prior art references are
21 non-analogous and the obviousness rejections are improper.

22 Further, the teachings of the Ganot patent and the Lebby patent
23 have been improperly combined with the teachings of the other
24 references to establish the obviousness rejections in the absence of any

1 suggestion or motivation for such combination. Referring to
2 MPEP §2146(j)(3), there must be some suggestion or motivation, either
3 in the references themselves or in the knowledge generally available to
4 one of ordinary skill in the art, to modify or combine reference
5 teachings. The mere fact that references *can* be combined or modified
6 does not render the resultant combination obvious *unless the prior art*
7 *also suggests the desirability of the combination.* MPEP §2143.01 citing *In*
8 *re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

9 Obviousness cannot be established by a combination of references
10 unless there is some motivation in the art to support the combination.
11 (*See ACH Hospital Systems, Inc. v. Montifiore Hospital*, 732 F.2d 1572, 1577,
12 221 USPQ 929, 933 (Fed. Cir. 1984). ("Obviousness cannot be established
13 by combining the teachings of the prior art to produce the claimed
14 invention, absent some teaching, suggestion or incentive supporting the
15 combination.")). The motivation for forming the combination must be
16 something other than hindsight reconstruction based on using Applicant's
17 invention as a road map for such a combination. *See, e.g., Interconnect*
18 *Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re*
19 *Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight
20 reconstruction is an improper basis for rejection of a claim).

21 For example, there is no suggestion in the prior art to suggest
22 utilizing the card printing method of the Kohno patent with the parking
23 lot tariff system of the Ganot patent. There is no motivation or
24 teaching in the art to combine the teachings of the formation of indicia

1 upon a surface of a portable registering device 10 as disclosed in the
2 Ganot patent upon a side of a card-thin housing as defined by
3 Applicant. There is no teaching or suggestion in the art to combine
4 the provision of indicia upon a portable registering device 10 as
5 disclosed in the Ganot patent with the teachings of the MacLellan and
6 Lebby references. The obviousness rejections of the claims are improper
7 for this additional reason.

8 Referring now to the rejection of claim 1 as stated on pages 3-4
9 of the Office Action, none of the MacLellan, Lebby or Ganot patents
10 teach or suggest the remote intelligent communication device defined in
11 claim 1. The references are devoid of teaching or suggesting providing
12 indicia upon a side surface having a dimension less than smallest
13 dimensions of the upper surface and lower surface of a card-thin
14 housing. Claim 1 is in condition for allowance.

15 Additionally, the mere fact that three references were required to
16 support an obviousness rejection of the remote intelligent communication
17 device defined in claim 1 is evidence of the non-obviousness nature of
18 the claimed remote intelligent communication device. Claim 1 is
19 allowable for this additional reason.

20 Claims 2-5 depend from independent claim 1 and therefore are in
21 condition for allowance for the reasons discussed above with respect to
22 claim 1 as well as for their own respective features which are neither
23 shown nor suggested by the cited art.
24

1 Referring to claim 6, a radio frequency identification
2 device (RFID) includes, in part, upper and lower surfaces individually
3 having plural dimensions and at least one side having a dimension
4 intermediate the surfaces less than smallest dimensions of the surfaces.
5 Further, the radio frequency identification device includes visibly
6 perceptible information upon the side. The references of record fail to
7 disclose a radio frequency identification device having a side as claimed
8 with visibly perceptible information. The prior art of record is
9 additionally devoid of teaching or suggesting any radio frequency
10 identification device having indicia. Claim 6 is in condition for
11 allowance.

12 Claims 7-12 depend from independent claim 6 and therefore are
13 in condition for allowance for the reasons discussed above with respect
14 to claim 6 as well as for their own respective features which are neither
15 shown nor suggested by the cited art.

16 Referring to claim 13, Applicant defines a card comprising, in
17 part, upper and lower surfaces individually having plural dimensions and
18 at least one side having a dimension less than smallest dimensions of
19 the upper and lower surfaces, and identification indicia on the side.
20 None of the prior art references either alone or in combination disclose
21 or suggest the card configuration defined in claim 13. Claim 13 defines
22 patentable subject matter and is in condition for allowance.

23 Claims 14-18 depend from independent claim 13 and therefore are
24 in condition for allowance for the reasons discussed above with respect

1 to claim 13 as well as for their own respective features which are
2 neither shown nor suggested by the cited art.

3 Claim 19 defines a communication device comprising, in part, a
4 housing having an upper surface and a lower surface interconnected by
5 side surfaces and the side surfaces individually have a dimension less
6 than smallest dimensions of the upper and lower surfaces. The
7 MacLellan, Lebby and Ganot patents fail to teach or suggest the
8 communication device defined in claim 19. Claim 19 is in condition for
9 allowance.

10 Claims 20-22 depend from independent claim 19 and therefore are
11 in condition for allowance for the reasons discussed above with respect
12 to claim 19 as well as for their own respective features which are
13 neither shown nor suggested by the cited art.

14 Claim 23 defines a method of forming a card comprising, in part,
15 providing a substrate having an upper surface, a lower surface and a
16 plurality of sides individually having a thickness less than the lengths
17 and widths of the surfaces. The method further defines encoding visibly
18 perceptible information on at least one of the sides. The MacLellan,
19 Lebby and Ganot patents are devoid of disclosing any structure or
20 methodology for forming a structure having visibly perceptible information
21 on a side having a thickness less than the lengths and widths of the
22 surfaces of the card. Claim 23 is patentable over the prior art of
23 record. Applicant respectfully requests allowance of claim 23.
24

1 Claims 24-26 depend from independent claim 23 and therefore are
2 in condition for allowance for the reasons discussed above with respect
3 to claim 23 as well as for their own respective features which are
4 neither shown nor suggested by the cited art.

5 Claim 27 defines a method of forming a card comprising, in part,
6 providing a card including an upper surface, a lower surface and a
7 plurality of sides, and the sides have a dimension less than smallest
8 dimensions of the upper and lower surfaces. The prior art of record
9 is entirely devoid of teaching or suggesting provision of such a method
10 as claimed. Accordingly, independent claim 27 defines patentable subject
11 matter over the prior art of record and is in condition for allowance.

12 Claims 28-30 depend from independent claim 27 and therefore are
13 in condition for allowance for the reasons discussed above with respect
14 to claim 27 as well as for their own respective features which are
15 neither shown nor suggested by the cited art.

16 Independent claim 31 defines a method of forming a
17 communication device comprising, in part, applying and curing an
18 encapsulant over a first substrate to form a composite substrate including
19 the first substrate and the encapsulant.

20 Referring to page 8 of the Office Action, it is stated that the
21 MacLellan patent fails to teach a communication device and method that
22 comprises a substrate having a support surface and a cured resin upon
23 the support surface. However, the Office Action states that the Lebby
24

1 patent discloses a cured resin upon a support surface as shown
2 in Fig. 2.

3 Referring to the Lebby patent, at lines 30-37 of column 3, it is
4 stated that an electrical interconnect and mounting board 25 of Fig. 2
5 may be a standard silver-plated copper flag or a printed circuit board
6 or a multilayer laminated board. Such fails to teach or suggest the
7 claimed method of applying and curing an encapsulant over the first
8 substrate to form a composite substrate. Referring to column 3,
9 lines 13-16 of the Lebby patent, casing 11 is formed of molding
10 portions 22, 23 which are molded to form casing 11. Such does not
11 disclose applying and curing an encapsulant over the first substrate to
12 form a composite substrate as claimed. The prior art references fail to
13 teach or suggest the method of claim 31. Claim 31 is in condition for
14 allowance for at least the above reason.

15 Claims 32-33 depend from independent claim 31 and therefore are
16 in condition for allowance for the reasons discussed above with respect
17 to claim 31 as well as for their own respective features which are
18 neither shown nor suggested by the cited art.

19 Claim 34 defines a method of forming a remote intelligent
20 communication device comprising, in part, encapsulating communication
21 circuitry thereby forming a card-thin housing with a substrate. Further,
22 the method includes providing a side having a dimension less than
23 smallest dimensions of upper and lower surfaces. The prior art
24

1 references fail to teach or suggest the method of claim 34. Independent
2 claim 34 is in condition for allowance.

3 Claims 35-38 depend from independent claim 34 and therefore are
4 in condition for allowance for the reasons discussed above with respect
5 to claim 34 as well as for their own respective features which are
6 neither shown nor suggested by the cited art.

7 Independent claim 39 defines a method of forming a
8 communication device comprising, in part, encapsulating an antenna,
9 transponder circuitry, battery and at least a portion of a substrate with
10 a flowable encapsulant and curing the flowable encapsulant on the
11 substrate into a solid housing.

12 Page 8 of the Office Action states that the Lebby patent teaches
13 the desire of a communication device and method having a cured resin
14 upon a support surface forming a housing. The Lebby patent discloses
15 a casing 11 including upper and lower plastic molded portions 22, 23
16 and does not disclose encapsulating using a flowable encapsulant and
17 curing the flowable encapsulant as defined in claim 39. The prior art
18 fails to teach or suggest the defined method and claim 39 is in
19 condition for allowance.

20 Claims 40-41 depend from independent claim 39 and therefore are
21 in condition for allowance for the reasons discussed above with respect
22 to claim 39 as well as for their own respective features which are
23 neither shown nor suggested by the cited art.
24

1 Independent claim 42 defines a method of encoding visibly
2 perceptible information on a communication device comprising, in part,
3 providing a card housing communication circuitry and the card having
4 upper and lower surfaces interconnected by side surfaces having a
5 dimension less than smallest dimensions of the upper and lower surfaces.
6 The Ganot patent merely teaches the provision of indicia upon a front
7 surface of a portable registration device and does not disclose or suggest
8 the provision of a card and the encoding of identification indicia on a
9 side surface of the card. Claim 42 is in condition for allowance.

10 Claims 43-45 depend from independent claim 42 and therefore are
11 in condition for allowance for the reasons discussed above with respect
12 to claim 42 as well as for their own respective features which are
13 neither shown nor suggested by the cited art.

14 Independent claim 46 defines a method of encoding visibly
15 perceptible information on a communication device comprising, in part,
16 providing a card housing communication circuitry and the card having
17 upper and lower surfaces interconnected by side surfaces having a
18 dimension less than smallest dimensions of the upper and lower surfaces.
19 There is no teaching or suggestion to provide identification indicia upon
20 the side surface as claimed. Claim 46 is in condition for allowance.

21 Claims 47-49 depend from independent claim 46 and therefore are
22 in condition for allowance for the reasons discussed above with respect
23 to claim 46 as well as for their own respective features which are
24 neither shown nor suggested by the cited art.

1 Applicant has made minor amendments to the Abstract and
2 line 11, page 15 of the Specification as indicated above.

3 Applicant respectfully requests allowance of all pending claims.

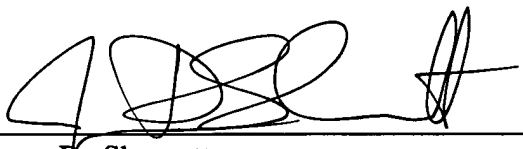
4 The Examiner is requested to phone the undersigned if the
5 Examiner believes such would facilitate prosecution of the present
6 application. The undersigned is available for telephone consultation at
7 any time during normal business hours (Pacific Time Zone).

8
9 Respectfully submitted,

10
11 Dated:

May 14, 1999

By:


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